

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Anuradha Narasimhaswamy Melkote et al.

Serial No.: 09/552,131

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For: ON-LINE INVENTION DISCLOSURE SYSTEM

Attorney Docket No.: 81056803

Group Art Unit: 2162

Examiner: Anh Ly

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Brief in support of an Appeal from the final rejection of claims 1-41 of the Office Action mailed on July 8, 2008 for the above-identified patent application.

I. REAL PARTIES IN INTEREST

The real parties in interest are Ford Global Technologies, Inc. and Ford Motor Company ("Assignees").

II. RELATED APPEALS AND INTERFERENCES

There are no appeals, interferences or judicial proceedings known to the Appellants, the Appellants' legal representative, or the Assignees which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-41 are pending in this application. Claims 1-41 have been rejected and are the subject of this appeal.

IV. STATUS OF AMENDMENTS

None.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 provides a method of forming an invention disclosure. The method includes forming an invention disclosure online by entering a plurality of selected information portions into a web-based system, Application, p. 9, l. 17 - p. 10, l. 22; p. 12, l. 19 - p. 13, l. 9, after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location, Figure 1, 18, and allowing access to various users comprising at least one inventor of said invention disclosure for reviewing the information, Application, p. 11, ll. 7-16. The method also includes allowing on-line access to the status of the invention disclosure, said status comprising where said invention disclosure is in a reviewing and application filing process, Application, p. 11, l. 17 - p. 12, l. 14.

Claim 17 provides an invention disclosure system including at least one user computer accessible by a plurality of inventors associated with a single invention disclosure, Figure 1, 14, a server coupled to said at least one user computer, Figure 1, 12, and a database coupled to the server, Figure 1, 18. Said server providing user screens to said at least one user computer to prompt said inventors to provide a plurality of disclosure information to said server, Application, p. 9, l. 17 - p. 10, l. 22; p. 12, l. 30 - p. 13, l. 4, receiving the plurality of disclosure information from said users, Application, p. 9, l. 17 - p. 10, l. 22; p. 12, l. 30 - p. 13, l. 4, storing information in said database after each of the plurality of disclosure information is entered, Figure 1, 18, allowing access to said disclosure after storing the plurality of disclosure information within said database, Application, p. 11, ll. 7-16, and

prompting said plurality of inventors for invention disclosure approval, Application, p. 13, l. 19 - p. 14, l. 7.

Claim 23 provides a method of forming an invention disclosure. The method includes forming an invention disclosure online by entering a plurality of selected information into a web-based system, Application, p. 9, l. 17 - p. 10, l. 22; p. 12, l. 19 - p. 13, l. 9, after each of the plurality of selected information is entered, storing each of the plurality of selected information in a central storage location, Figure 1, 18, and allowing access to various users to access the information, Application, p. 11, ll. 7-16. The method also includes prompting the user for classification information which refers to a technology area, Application, p. 10, ll. 11-13, notifying an evaluator in response to the classification information, Application, p. 11, ll. 9-14, and prompting an evaluation from the evaluator, Application, p. 11, ll. 9-16.

Claim 37 provides a method of submitting documents. The method includes entering identification information into a user computer, Application, p. 9, ll. 20-28; p. 12, ll. 19-23, retrieving user information from a directory system in response to said identification information, Application, p. 9, ll. 20-28; p. 12, ll. 25-27, and entering disclosure information to create an invention disclosure, Application, p. 10, ll. 6-22; p. 12, l. 27 - p. 13, l. 9. The method also includes coupling said user information with said invention disclosure, Application, p. 9, ll. 28-30, storing the disclosure in a computer database, Figure 1, 18, and performing a search to determine the state of the art associated with said invention disclosure wherein said search is at least partially directed by at least one inventor of said invention disclosure, Application, p. 15, l. 13 - p. 16, l. 12.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-20, 22-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pub. No. 2002/0095368 (Tran), U.S. Pub. No. 2006/0010377 (Anecki) and U.S. Pub. No. 2001/0049707 (Tran707). Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tran, Anecki and U.S. Pub. No. 2006/0190443 (Mathews).

VII. ARGUMENT

A. Claims 1-20, 22-41 Are Patentable Under 35 U.S.C. 103(a) Over Tran, Anecki And Tran707

With regard to claim 1, Anecki does not disclose allowing access to various users comprising at least one inventor of said invention disclosure for reviewing the information. Anecki simply does not discuss invention disclosures or inventors. Nevertheless, the Examiner argues that

Anecki teaches users may access and control the legal document creation and approval process (page 3, paragraphs 0046, lines 1-5 and 0047, lines 2-6). Legal document is a kind of IP document, from which the user granted access or allowed access and controlled its status such as approval of status of a legal document; tracking of legal documents once the legal documents are issued to the customer or client or inventor (page 3, paragraph 0047, lines 1-6).

Office Action, July 8, 2008, p. 3.

To the extent the Examiner argues that the above limitation is inherent to Anecki, the Examiner does not carry the burden:

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the

thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

MPEP 2112.

The Examiner's argument that "[l]egal document is a kind of IP document . . ." does not "make clear that the missing descriptive matter is necessarily present . . . and that it would be so recognized by persons of ordinary skill."

With regard to claim 1, Anecki does not disclose allowing on-line access to the status of the invention disclosure, said status comprising where said invention disclosure is in a reviewing and application filing process. As explained above, Anecki does not discuss invention disclosures or inventors. As such, Anecki cannot disclose the above limitations.

With regard to claim 17, Anecki does not disclose allowing access to said disclosure after storing the plurality of disclosure information within said database and prompting said plurality of inventors for invention disclosure approval. As explained above, Anecki does not discuss invention disclosures or inventors. As such, Anecki cannot disclose the above limitations.

With regard to claim 23, Tran does not disclose prompting the user for classification information, which refers to a technology area. The Examiner relies on passages in paragraphs [0016], [0019] and [0043] of Tran to find the above limitation. These passages, however, discuss buying, selling and estimating the value of IP assets. As an example, paragraph [0019] states that

The Appraise button provides an electronic valuation module to estimate the value of the IP assets. Factors evaluated include

term of duration of rights; status of applications made in foreign countries and fights approved there; litigation with third parties; licensing status; technical nature of invention (three categories: basic technology, vastly improved technology and marginally improved technology); related patents; technical dominance of the IP asset, as judged by degree to which invention has been developed into a superior concept, extent and clarity of specification; clarity of range of technology if there is something unclear in the range of technology for which fights have been formed or there is concern over the occurrence of infringement-related disputes; relationship to use of IP rights possessed by third party; technical superiority to substitute technology; extent to which invention has been proven in real use; necessity of additional development for commercialization; markets for commercialization; transfer and distribution potential; inventors (or right-holders)'s intent to engage in continual research and development and the possibility of applying the results; potential restrictions on the places that it can be licensed to (such as limits on the term and region of implementation); the right-holder's ability to exercise its rights against infringing parties; the possibility that rights will be invalidated, canceled, or limited; the business potential of the invention; the possibility that substitute technology for the invention will be developed; the potential for competing or substitute products will appear; the ease that imitation products be easily manufactured; the ease of detecting infringing products; the size of the market, the market scale, the market share that is acquirable and the time frame for acquiring the targeted market share; the life span for the product's market; the price that a customer is willing to pay for the value generated by the relevant patent right; and the sustainability of the profit.

Tran, [0019].

Buying, selling and estimating the value of IP assets has nothing to do with prompting the user for classification information, which refers to a technology area.

With regard to claim 23, Anecki does not disclose allowing access to various users to access the information, notifying an evaluator in response to the classification

information and prompting an evaluation from the evaluator. As explained above, Anecki does not discuss invention disclosures or inventors. As such, Anecki cannot disclose the above limitations.

With regard to claim 37, Anecki does not disclose performing a search to determine the state of the art associated with said invention disclosure wherein said search is at least partially directed by at least one inventor of said invention disclosure. The Examiner attempts to find this limitation in passages of Anecki concerning "NDA's." See, Office Action, July 8, 2008, p. 5. "NDA's," however, are not state of the art searches for invention disclosures. Moreover, Anecki does not discuss invention disclosures or inventors, *a fortiori*, state of the art searches for invention disclosures.

Assuming, *arguendo*, Tran and Anecki disclose the elements of claims 1, 17, 23 and 37 as argued by the Examiner, the Examiner has failed to establish a *prima facie* case of obviousness. The Examiner asserts that it would have been obvious to combine Tran and Anecki "for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing" Tran, however, is directed to systems and methods for trading intellectual property. Tran, Abstract. Tran states that

Systems and methods cost-effectively are disclosed to facilitate and enhance the licensing and trading of IP assets. The system supports purchasing or selling of intellectual property related products and services with a computerized bid, auction and sale system over a network such as the Internet. The techniques provide IP owners with access to an open market for trading IP. The techniques support a service-based auction network of branded, online auctions to individuals, businesses, or business

units. The techniques offer a quick-to-market, flexible business model that can be customized to fit the IP needs of any industry and target technology.

Tran, [0006].

The apparent “open market for trading IP” provided by Tran has nothing to do with the “tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation.” Tran is directed to systems and methods to “facilitate and enhance the licensing and trading of IP assets.” Tran, [0016]. The licensing and trading of IP assets has nothing to do with “document preparation.” One of ordinary skill, therefore, would not have had reason to combine Anecki with Tran.

Assuming, *arguendo*, Tran, Anecki and Tran707 disclose each and every element of claims 1, 17, 23 and 37, the Examiner has not cited reasons sufficient to establish a *prima facie* case of obviousness. See, MPEP 2142 (“[R]jections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) The Examiner asserts that it would have been obvious to combine Tran, Anecki and Tran 707 “for the purpose of procuring intellectual property assets, thereby enabling user to locate and navigate the information needed to procure IP assets” This vague, conclusory reasoning, however, appears to lack technical merit. Tran707 is directed to patent-it-yourself type software: “Software that can be downloaded from the server 100 includes a module to assist a user in generating a patent application,” Tran707, [0041]; “Since the member is generating the bulk of the work product, the cost in procuring the IP asset is reduce, while responsiveness is enhanced,” Tran707, [0089]. Why would one of ordinary skill find reason to combine Tran and Anecki with Tran707 when Tran707 already appears to assist in “procuring intellectual property assets” and “enable user to locate and navigate information needed to procure IP assets,” see, Tran707, [0041]-[0080]?

Claims 2-16, 18-20, 22, 24-36 and 38-41 are patentable because they depend from one of the independent claims.

**1. Claim 3 Is Separately Patentable Under
35 U.S.C. 103(a) Over Tran, Anecki And Tran707**

With regard to claim 3, Anecki does not disclose prompting the user for classification information classifying the invention disclosure into a technology area. As explained above, Anecki does not discuss invention disclosures or inventors. As such, Anecki cannot disclose the above limitation. The Examiner, however, relies on the "Automated Nondisclosure Agreement" (ANDA) of Figure 12, the "Filter" button of Figure 21, and the following passages of Anecki to find the above limitation:

FIG. 12 is a subject matter description of selected products for an embodiment of the present invention. The subject matter of a NDA can range from the physical products provided as samples to the business information applicable to the intended use of the physical products. For example, field 2000 contains information about networking products protected by the NDA. Additionally, protected material includes not only the physical chips 2002, but the relationships between business associates 2004. The information protected by the NDA includes "[a]ll technology road map, business models, and technical data" 2006.

Anecki, [0108].

FIG. 21 is a search entry form of a legal document status reporting embodiment of the present invention. The form includes a customer name entry field 2900 for entry of a recipient name used to search the legal document database. A legal document administrator searches of legal documents issued to recipient by entering a recipient name in the customer name entry field and selecting the "Filter" button 2902.

FIG. 22 is a search entry form and a filtered result list of a legal document status reporting embodiment of the present invention. This form can be the same form as the form illustrated in FIG. 21 after entering a recipient name in the customer name entry field 2900 and selecting the "Filter" button 2902. The form includes a recipient list portion 3000 including an identifier 3002 for a legal document recipient. Selecting the identifier brings up a legal document status report of legal documents sent to the recipient a legal document server.

Anecki, [0122]-[0123] (emphasis added).

In one embodiment of a legal document server, a legal document administrator can create an amendment to an existing legal document and send the amendment to a recipient. Referring again to FIG. 22, a legal document administrator uses the previously described search entry form and a filtered result list to select a legal document to amend.

Anecki, [0128].

The "filtering" discussed above is based on a search of a recipient's name of a legal document. A name based search has nothing to do with classification information classifying an invention disclosure into a technology area. Moreover, the "filtering" discussed above does not appear to have anything to do with the ANDA of Figure 12.

2. Claim 4 Is Separately Patentable Under 35 U.S.C. 103(a) Over Tran, Anecki And Tran707

With regard to claim 4, Anecki does not disclose selecting an evaluator based on the classification information. As discussed above, Anecki does not disclose classification information: Anecki cannot disclose the above limitation. The Examiner, however, relies on the following passages of Anecki to find the above limitation:

FIG. 7 is a sequence diagram of an embodiment of a process for providing an approval status report according to the present

invention. A legal document server begins the process of generating a legal document 1600. In this example, the generation of the legal document requires approval from two directors, director A and director B. Director A evaluates the request and approves the legal document generation by sending a director A approval 1601 to the legal document server using a director A client 1602. The legal document server updates the legal document in progress 1604 and puts the updated status of the legal document in progress into a database maintained by a legal document database server 1402.

Anecki, [0092].

Nothing in the above, however, indicates that the "directors" are selected based on classification information classifying an invention disclosure into a technology area.

**B. Claim 21 is Patentable Under
35 U.S.C. 103(a) Over Tran, Anecki And Mathews**

Claim 21 is patentable because it depends from claim 17.

The fee applicable under the provisions of 37 C.F.R. § 41.20(b)(2) is enclosed. Please charge any additional fee or credit any overpayment in connection with this filing to our Deposit Account No. 06-1510.

Respectfully submitted,

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Enclosure - Appendices

VIII. CLAIMS APPENDIX

1. A method of forming an invention disclosure comprises the steps of:
forming an invention disclosure online by entering a plurality of selected information portions into a web-based system;
after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location;
allowing access to various users comprising at least one inventor of said invention disclosure for reviewing the information; and
allowing on-line access to the status of the invention disclosure, said status comprising where said invention disclosure is in a reviewing and application filing process.
2. The method as recited in claim 1 wherein said step of forming includes providing identification information; whereby upon providing identification information to said web-based server, retrieving user information from the directory system in response to the identification information.
3. The method as recited in claim 1 further comprising the step of prompting the user for classification information classifying the invention disclosure into a technology area.
4. The method as recited in claim 3 further comprising the steps of selecting an evaluator based on the classification information and prompting an evaluation from the evaluator.
5. The method as recited in claim 4 wherein the step of prompting an evaluation from the evaluator comprises the steps of generating an e-mail and providing a hyperlink to the disclosure in the e-mail.

6. The method as recited in claim 4 wherein the step of prompting an evaluation comprises scheduling an evaluation meeting.

7. The method as recited in claim 4 wherein the step of prompting an evaluation comprises ranking the disclosure.

8. The method as recited in claim 3 further comprising the step of notifying a patent staff person in response to the classification information.

9. The method as recited in claim 8 further comprising the step of prompting a patentability review from the patent staff person.

10. The method as recited in claim 1 wherein said central location comprises a database coupled to a web server.

11. The method as recited in claim 1 further comprising the steps of identifying co-authors; notifying co-authors of a disclosure with their name associated therewith in the system.

12. The method as recited in claim 11 wherein said step of notifying comprises the step of generating an e-mail having a hyperlink therein.

13. The method as recited in claim 1 wherein said status comprises where said invention disclosure is in a patent office evaluation process.

14. The method as recited in claim 1 wherein said status is provided update via e-mail.

15. The method as recited in claim 1 wherein the step of allowing access comprises prompting users for a password.

16. The method as recited in claim 1 further comprising the step of accepting a paper submission; and
wherein the step of forming comprises scanning said paper submission into the database.

17. An invention disclosure system comprising:
at least one user computer accessible by a plurality of inventors associated with a single invention disclosure;
a server coupled to said at least one user computer;
a database coupled to the server;
said server providing user screens to said at least one user computer to prompt said inventors to provide a plurality of disclosure information to said server, receiving the plurality of disclosure information from said users, storing information in said database after each of the plurality of disclosure information is entered, allowing access to said disclosure after storing the plurality of disclosure information within said database, and prompting said plurality of inventors for invention disclosure approval.

18. The system as recited in claim 17 further comprising a directory system coupled to said server whereby upon proving identification information to server said server retrieves user information from the directory system in response to the identification information.

19. The system as recited in claim 17 wherein said server comprises a web server.

20. The system as recited in claim 17 wherein said user computer comprises a web browser for accessing said server.

21. The system as recited in claim 18 wherein said user computer comprises a computer aided design (CAD) file viewer coupled to said web browser.

22. The system as recited in claim 17 wherein said server comprises a web single login to access said invention disclosure.

23. A method of forming an invention disclosure comprising:
forming an invention disclosure online by entering a plurality of selected information into a web-based system;
after each of the plurality of selected information is entered, storing each of the plurality of selected information in a central storage location;
allowing access to various users to access the information;
prompting the user for classification information, which refers to a technology area;
notifying an evaluator in response to the classification information; and
prompting an evaluation from the evaluator.

24. The method as recited in claim 23 wherein said step of forming includes providing identification information; whereby upon providing identification information to said web-based server, retrieving user information from the directory system in response to the identification information.

25. The method as recited in claim 23 wherein the step of notifying an evaluator comprises the step of generating an E-mail; providing a hyperlink to the disclosure in the e-mail.

26. The method as recited in claim 23 wherein the step of prompting an evaluation comprises scheduling an evaluation meeting.

27. The method as recited in claim 23 wherein the step of prompting an evaluation comprises ranking the disclosure.

28. The method as recited in claim 23 further comprising the step of notifying a patent staff person in response to the classification information.

29. The method as recited in claim 23 further comprising the step of prompting a patentability review from the patent staff person.

30. The method as recited in claim 23 wherein said central location comprises a database coupled to a web server.

31. The method as recited in claim 23 further comprising the steps of identifying co-authors; notifying co-authors of a disclosure with their name associated herewith in the system.

32. The method as recited in claim 23 wherein said step of notifying comprises the step of generating an e-mail having a hyperlink therein.

33. The method as recited in claim 23 further comprising the step of viewing the status of the invention disclosure on-line.

34. The method as recited in claim 23 further comprising the step of providing a status update via e-mail.

35. The method as recited in claim 23 wherein the step of allowing access comprises prompting users for a password.

36. The method as recited in claim 23 further comprising the step of accepting a paper submission; and
wherein the step of forming comprises scanning said paper submission into the database.

37. A method of submitting documents comprising:
entering identification information into a user computer;
retrieving user information from a directory system in response to said identification information;
entering disclosure information to create an invention disclosure;
coupling said user information with said invention disclosure;
storing the disclosure in a computer database;
performing a search to determine the state of the art associated with said invention disclosure; and
wherein said search is at least partially directed by at least one inventor of said invention disclosure.

38. The method as recited in claim 37 further comprising the step of prompting the user for classification information.

39. The method as recited in claim 38 further comprising the steps of notifying an evaluator in response to the classification information, prompting an evaluation from the evaluator.

40. The method as recited in claim 37 further comprising the step of notifying a patent staff person in response to the classification information.

41. The method as recited in claim 40 further comprising the step of prompting a patentability review from the patent staff person.

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.